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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,512	10/31/2001	Stanley T. Lim	004867.P004	3244
7590	07/17/2006		EXAMINER	
Tarek N. Fahmi BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	
				DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/001,512	LIM ET AL.	
	Examiner Jean D. Janvier	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 and 14-43 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 and 14-43 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

## **DETAILED ACTION**

### **Specification**

#### ***Status of the claims***

1-12 and 14-43 are currently pending in the Instant Application, while claims 13 and 44-88 are being canceled.

#### ***Claim Objections***

Claims 17, 19, 20, 23, are objected to because of the following informalities-

Concerning claim 17, 19, 20, 23, the user is the recipient of the third party advertisement and the compensation and thus, it is rather unclear how the user can adjust the reward threshold, especially since the reward or compensation is provided by the third party advertiser who has the latitude to adjust the reward threshold.

Still concerning claim 23, the limitations recited therein are confusing since the user is primarily designated as the recipient of the messages, then "allowing the user to provide the maximum number of messages within a designated time frame" is ambiguous. Here and throughout the claimed invention, it appears that the term

"user" has two different meanings namely a recipient (who receives the advertisements for viewing) and/or an administrator or advertiser (who prepares the advertisements).

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent; or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-12 and 14-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldhaber, US Patent, 5, 794, 210.

As per claims 1-12 and 14-43, Goldhaber et al. disclose a method and/or system for brokering and selling the attention of the customer wherein, among other things, advertisers are bidding for the opportunity to have their ads read by a customer or subscriber of the system depending upon the highest credit or compensation offered for the customer's attention. By clicking on a Cybercoin button (or inherent banner, ad box or link) or selectable object, displayed on the customer's PC 104, representing an ad, a customer indicates his intention to read the said ad and once the system verifies, through a quiz process or a test, that the customer has indeed read or interacted with the ad or advertisement, which guarantees that the advertiser's message has received full attention or interaction, the customer is compensated in the form of credits or digital cash for paying attention to the ad (determining whether or not the user accesses the system to read or view an advertisement or uses his reasoning to answer questions or respond to the quiz and subsequently receives a compensation for reading or viewing the advertisement. The latter guarantees that an Internet operation, that is accessing a web site and reading an advertisement, has been performed and that the user has interacted with the displayed advertisement, thereby measuring the system effectiveness (Col. 16: 6-16; fig. 12; col. 7: 48-61; col. 11: 32-38; see also claims 1, 13 and 14 of the current reference; see abstract).

In short, Goldhaber teaches a system for providing an incentive to a qualified customer to read at least one advertisement from an advertiser. An icon or gold coin is displayed on the customer's computer screen when the customer logs into the system. And if the customer takes an action or clicks on the gold coin, then an advertisement associated with the displayed coin is presented to the customer and an account related to the customer is credited accordingly upon verifying that the customer has indeed viewed or interacted with the presented advertisement. To this end, prior to crediting the customer's account, a quiz or a questionnaire related to the displayed advertisement or a game based on the component of the advertisement is being generated and presented to the customer within a Graphical User Interface (GUI) or within a Web page of the associated web site before the consumer or the consumer's PC accesses a database to retrieve the digital cash or resource associated with the reading of the advertisement (reads on the step of creating a graphical image with information on the question) and if the customer correctly answers the quiz or the questionnaire (reads on the matching step) or registers a high score while playing the generated game, then it can be positively concluded that the customer has in fact read the displayed advertisement and the customer's account can be credited accordingly (See abstract; col. 7: 48-61; Col. 16: 6-16; fig. 12; see also claims 1, 13 and 14).

### **Response To Applicant's Arguments**

First, in "wherein the filter (profile) includes settings for rewards thresholds", as featured in at the independent claims, the new claim language represents one more

profile or filter parameters that makes up, in addition to demographics and other characteristics, the profile or filter that controls the delivery of advertisements to a user. Further, it appears that, even when expressly recited, that the "settings for rewards threshold" limitation does not really affect the delivery of the advertisements to the user. In other words, the claims do not specifically recite, for example, the step of "including the setting rewards thresholds as part of the profile or filter data, which indicates the willingness of the user to accept or read at least one advertisement for a specific amount of money or credits and the system is operable to compare an amount offered by an advertiser to read the advertisement to the specific amount acceptable to the user as read from the setting for rewards threshold". As seen here, simply incorporating the "setting for rewards threshold" as one additional parameter does not immediately or individually impact or control the delivery of advertisements to the user and thus, this is a nominal recitation.

Additionally, Applicant argues that the Goldhaber's system does not allow the qualified user to tailor the types of advertisements he sees, nor does Goldhaber provide a system by which a user is able to identify the types and amounts of rewards he requires before he views an advertisement. Here, the argued limitations are not necessarily claimed. Moreover, the user does not tailor advertisements to himself, but the system uses the user's filter or profile to deliver customized advertisements to the user for a certain amount of money (reward threshold) as the claims seem to suggest and as supported by the prior art in general.

Hence, and in view of the foregoing response, Applicant's arguments are not plausible and the current Office Action has been made final.

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,724,521A to Dedrick discloses a system wherein an advertiser is charged for the amount of time a user spends reading advertising messages from the advertiser and wherein the user is compensated accordingly.

USP 6,195,698B1 to Lillibridge discloses a method for selectively accepting access requests from a client computer connected to a server computer by a network. The server computer receives an access request from the client computer. In response, the server computer generates a predetermined number of random characters. The random characters are used to form a string in the server computer. The string is randomly modified **either visually or audibly to form a riddle**. The original string becomes the correct answer to the riddle. The server computer renders the riddle on an output device of the client computer. In response, the client computer sends an answer to the server. Hopefully, the answer is a user's guess for the correct answer. The server determines if the guess is the correct answer, and if so, the access request is accepted. If the correct answer is not received within a predetermined amount of time, the connection between the client and server computer is terminated by the server on the

assumption that an automated agent is operating in the client on behalf of the user (See abstract)

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

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Official Draft : 571-273-8300

**Jean D. Janvier**

**JDJ**

**Patent Examiner**

07/04/06

Art Unit 3622

JEAN D. JANVIER  
PRIMARY EXAMINER

